

Practitioner's Docket No. 200405.00024

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Coslovi et al.

Application No.: 09/650,388

Group No.: 3617

Filed: August 29, 2000

Examiner: Jules, F.

For: VEHICLE CARRYING RAILROAD CAR AND BRIDGE PLATE THEREFOR

Mail Stop Appeal Briefs – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 1.192)

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on August 17, 2004.

2. STATUS OF APPLICANT

This application is on behalf of a large entity.

3. FEE FOR FILING APPEAL BRIEF

The fee for filing the Appeal Brief is:

large entity \$340.00

Appeal Brief fee due \$340.00

CERTIFICATION UNDER 37 C.F.R. § 1.8(a)

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope with sufficient postage as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

19 October 2004

Signature

Michael H. Minns

(type or print name of person certifying)

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

| | |
|------------------------|----------|
| Appeal brief fee | \$340.00 |
| Extension fee (if any) | \$0.00 |

TOTAL FEE DUE \$340.00

6. FEE PAYMENT

Attached is a check in the amount of \$340.00.

7. FEE DEFICIENCY

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AF/3617
H

Attorney's Docket 200405.00024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of:

Inventors: Ilario Coslovi and James W. Forbes
Serial No: 09 / 650,388
Filed: August 29, 2000
Title: Vehicle Carrying Railroad Car And Bridge Plate Therefor
Assignee: National Steel Car
Art Unit: 3617
Examiner: Frantz F. Jules

APPLICANT'S BRIEF ON APPEAL

To: Mail Stop Appeal Brief- Patents
The Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal under 37 C.F.R. § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of claims 3 – 32 in the above-identified patent application. The Applicants' Brief on Appeal is filed with the requisite filing fee under 37 C.F.R. § 41.20(b)(2).

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of the Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Arguments
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

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The final page of this brief bears the practitioner's signature.

I. Real Party in Interest

The real party in interest in the present application is National Steel Car Limited, by assignment from the inventors Ilario Coslovi and James W. Forbes. The assignment is recorded in the United States Patent and Trademark Office at Reel 011066, Frame 0482.

II. Related Appeals and Interferences

There have been neither interferences relating to this pending application, nor any related appeal or litigation.

III. Status of Claims

The status of the claims in this application are:

1. Total Number of Claims in Application

There were 46 claims pending in this application, numbered 1 to 46.

2. Status of All of the Claims

- A. Claims cancelled: Two, namely claims 1 and 2.
- B. Claims withdrawn from consideration but not cancelled: None
- C. Claims pending: Forty-four, namely claims 3 to 46.
- D. Claims allowed: There are 14 allowed claims, namely claims 33 – 46
- E. Claims objected to: There are 7 claims to which there is an objection, but that would be allowable if re-written in independent form, namely claims 11, 16, 17, 19, 21, 22 and 27.
- F. Claims rejected: There are 23 rejected claims, namely claims 3 – 9, 10, 12 – 15, 18, 20, 23 – 26 and 28 – 32.

3. Claims on Appeal

The claims on appeal are Claims 3 – 9, 10, 12 – 15, 18, 20, 23 – 26 and 28 – 32.

IV. Status of Amendments

The claims were last amended on August 20, 2002 at the time of filing of the Request for Continued Examination in this matter. The amendments submitted at that time have been entered in the case and are reflected in the current status of the claims.

No amendment have been filed, subsequent to the rejection from which this appeal is taken, therein contained in the Office Action mailed May 17, 2004.

V. Summary of the Invention

The invention is summarised in the presently pending claims. With respect to the presently rejected claims, generally speaking, in one aspect reflected in independent claim 3, it relates to a rail road car bridge plate that is operable to permit a vehicle to be conducted between respective vehicle decks of a pair of first and second coupled railroad cars. The bridge plate is locatable to span a gap between the railroad cars when the railroad cars are in motion, and has a fitting permitting the beam to be moved to a cross-wise orientation when disengaged from the second railroad car. (Page 9, lines 4 to 11)

In another aspect reflected in independent claim 13, which is generally similar to that of independent claim 3, and also includes fittings at either end thereof permitting longitudinal variation of distance between first and second axes of the adjacent railroad cars, and in which one of the two fittings is disengageable. (Page 9, line 31 to page 10, line 10)

In another aspect of the invention, reflected in independent claim 20, which is also generally similar to that of claim 3, there is a bridge plate that has a pivot fitting at one end, and a second fitting at the other end, the second fitting including a linear extension member, and being disengageable from an adjacent railroad car. (Page 10, lines 20 to 27, and page 10 lines 8 to 11).

In still another aspect of the invention, reflected in independent claim 20, which is also generally similar to that of claim 3, there is a bridge plate kit which includes a bridge plate having first and second fittings at its respective ends, and in which one of the fittings is disengageable. (Page 10, line 36 to page 11 line 7, and page 10, lines 8 to 11).

Although specific page and line numbers have been given in parentheses, above, the application is replete with supporting material for all of the presently pending claims, both in the text and in the illustrations. Figures 3h, 4a – 4e, and 5a – 5c may be noted.

VI. Grounds of Rejection to be Reviewed on Appeal

The current grounds of rejection are given in the following statements, from the Office Action of May 17, 2004:

“2. Claims 3- 7, 9 – 10, 13 – 15, 20, 23, 24 – 26, 29 – 32 are rejected under 35 U.S.C. §102(b) as being anticipated by Black, Jr., et al. (US 5,782,187).

Claims 3 – 7, 9 – 10, 13 – 15, 20, 23, 24 – 26, 29 – 32

Black Jr., et al. teach all the limitations of claims 3 – 7, 9 – 10, 13 – 15, 20, 23, 24 – 26, 29 – 32 by showing in figs 1-9, a railroad car bridge plate operable to permit a vehicle to be conducted between two railroad cars (22a, 22b) as disclosed in col. 9, lines 45 – 50 and fig. 6, said bridge plate (32) comprising a beam locatable in a longitudinal orientation of sufficient length to span a gap between a pair of adjacent railroad cars (22a, 22b), said beam having an upwardly facing track surface or flange (34) for vehicle [sic] to ride on, said beam having a first pivot fitting (102a) allowing mounting of the beam to the railroad car (22a), said beam having a second fitting (102b) for engaging a second railroad car (22b) said fittings being operable to accommodate yawing of said beam relative to the first or second railroad cars (22a, 22b) when said beam is located in the longitudinal orientation, and the railroad cars [sic: are ?] in motion and one of said first and second fittings and said fitting [sic ?] permitting movement in a cross-wise orientation relative to the first railroad car when said beam is disengaged from the second railroad car. The yawing motion of the beam in a direction transverse to the longitudinal plane of the railcars will result whenever the two railroad cars are is [sic] to be disconnected since a polymeric collar (111) is provided around the member (102) as shown in fig. 8 for low friction sliding of the fittings 102a and 102b within their respective slots 106a and 106b as disclosed in col. 9, lines 51 – 53.”

“The first and second railroad cars are releasably coupled to one another or are disengageable since a threaded connection is used to connect the bridge plate to the railroad cars. Moreover said fitting consisting of collars (111, 102) for receiving a vertical pivot pin (105), said bridge plate being translatable relative to said second axis whenever one of the pivot pins is removed since a threaded bolt member (105) is used to connect the bridge plate (32) to the railcar (22a or 22b), see fig. 8.”

“4. Claims 8, 12, 18, 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Black Jr. et al. '187 in view of Thompson '478”

Claims 8,12, 18, 28

Black Jr. et al. teach all the limitations of claims 8, 12, 18, 28 except for a railroad car bridge plate having traction bars on the upper surface and a handgrab mounted thereto. The general concept of using traction bars on the top surface of an Aluminum bridge plate assembly of two railroad car units is well known in the art as illustrated by Bell et al., see fig. 1, column 1, lines 60 – 67, column 2, lines 49 – 51. Also the general concept of adding a hand grab to a bridge plate assembly of a railroad car unit is well known in the art as illustrated by Thompson '478. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Black Jr. et al. to include the use of traction bars on the top surface of an Aluminum bridge plate assembly in his advantageous bridge plate as taught by Bell et al. in order to reduce slippage on the bridge plate assembly thereby increasing safety. In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Black Jr. et al. to include the use of a hand grab to the bridge plate assembly in his advantageous bridge plate as taught by Thompson '478 in order to facilitate rotation or handling of the bridge plate when the railroad cars are disconnected for service.”

VII. Argument

Grouping of Claims

The claims under appeal include independent claims 3, 13, 20, 24 and 33 and dependent claims 4-10, 12, 14, 15, 18, 23, 26 and 28-32. The claims do not rise or fall together.

Rejections Under 35 U.S.C. §102 - Anticipation

Law of Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, G.m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on

conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

Commentary on Rejections Under 35 U.S.C. §102: US Patent 5,782,187 of Black, Jr.

Claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 stand rejected as being anticipated by US Patent 5,782,187 of Black, Jr., et al.

The test for anticipation requires that the cited reference show all of the elements of the claim in exactly the same situation and united in the same way to perform the same function. Consider, first, claim 3.

I) Claim 3 is premised on the existence of bridge plates that span the gap between the coupler ends of the two rail road cars. Black does not show this:

- (a) Black shows one railroad car, not two.
- (b) Black does not show the coupler ends of any railroad car.
- (c) Black does not show coupler end bridge plates.
- (d) Black does not show a gap between two coupled railroad cars.
- (e) Black does not show bridge plates spanning the gap between the coupler ends of two coupled railroad cars

The Applicant notes Black Jr., at col. 2, lines 50 – 64:

“The pivot plate assembly also may comprise *bridge plates for spanning the gap between the respective first and second units of the railway car*. The bridge plates provide supporting surfaces for rolling of vehicle over the articulation from one of the platforms to the other to facilitate rolling loading and unloading of vehicles from one unit to another.

The platforms may partially overlap the bridge plates to provide a continuous, uninterrupted movable support surface to be provided adjacent the articulation. Each of the platforms preferably comprises one or more molded polymeric structures having a ribbed bottom surface to provide light weight while maintaining high strength and rigidity.” (Emphasis added).

The key concept that does not seem to have been understood by the Examiner throughout this prosecution is that Black’s Figures 1 to 6 illustrate a portion of a single articulated rail road car.

By definition, an articulated railroad car (singular) has two or more rail road car body units

(plural). The individual body units are not separate railroad cars.

Black shows an internal portion of a rail road car (singular).

Black's rail road car (singular) includes item **22a** and item **22b**, namely a pair of first and second rail road car units (plural) of Black's rail road car (i.e., "*of the railway car*", the definite article "the" being employed by Black).

Hence, in clear contradiction of the Examiner's position, Black Jr., et al., clearly state that the bridge plates span the gap between "*the respective first and second units (plural) of the railway car (singular)*".

The Applicant respectfully submits that the Black Jr., reference does not support the rejection in the Office Action. On the contrary, it supports the position of the Applicant.

- (a) Black does not, in any Figure, illustrate a coupler end of any railroad car.
Black does refer to the internal articulated connection of a single articulated railroad car.
- (b) Black does not, in any Figure, illustrate two rail road cars coupled together.
Black does show portions of two rail car units of a single articulated railroad car.
- (c) Black does not, in any Figure, show bridge plates spanning the gap between the coupler ends of two rail road cars.
Black does show internal bridge plates spanning the internal gap at the articulated connector.

The applicant respectfully submits that any one of these grounds would be sufficient to overcome the present rejection under 35 U.S.C. §102.

Examiner Continues to Contradict the Reference

The cited Black, Jr., reference shows permanently mounted bridge plates located between two car units of a single articulated rail road car. The aspects of the invention presently claimed relate to a bridge plate for use at the coupled end of a rail road car, to span the gap between vehicle decks at the couplers. The background of the invention at page 4, lines 21 – 34, notes that the internal bridge plates mounted at a permanent articulated connector of an articulated rail road car face different design criteria and operating requirements than bridge plates at the coupler ends.

The figures of Black, Jr., cited by the Examiner, do not reveal anything about coupler end bridge plates. The Abstract makes no reference to coupler end bridge plates, but rather makes it abundantly clear that the bridge plates cited by the Examiner are "over the articulation between interconnected railway car units". Black, Jr. repeatedly states that the bridge plates are mounted between pivotally interconnected units, supporting the argument presented by the Applicant.

In this regard, the applicant specifically notes that the descriptions starting in the Office Action mailed October 18, 2002, and continuing through the following Office Actions of May 13, 2003, December 24, 2003, and May 17, 2004 have repeatedly, and incorrectly stated that Black, Jr., shows “...said bridge plate (32) comprising a beam locatable in a longitudinal orientation of sufficient length to span a gap between a pair of adjacent railroad cars (**22a**, **22b**), ...”

As the Applicant has repeatedly pointed out, the foregoing statement flatly contradicts the text of the cited Black Jr., reference in this regard. Items **22a** and **22b** are not adjacent rail road cars. On the contrary, car units **22a** and **22b** are units of a single articulated rail road car, **22** as plainly indicated by Black, Jr., at, for example, col. 4, lines 1-7. The Examiner’s attention has been repeatedly drawn to Figures 1 and 2 of Black, Jr., which show a single shared railway truck supporting the adjacent internal ends of the two permanently interconnected units **22a** and **22b**.

The Office Action of May 17, 2004 does not responded to this argument. Specifically:

- 1) It does not acknowledge that Black items **22a** and **22b** are units of a single articulated railroad car, not two railroad cars.
- 2) It does not acknowledge that Black does not show coupler end bridge plates.
- 3) It does not acknowledge that Black item **32** is not a coupler end bridge plate.
- 4) It does not acknowledge that the Examiner’s statement contradicts the reference.

The Office Action of May 17, 2004 does not address any of these points, although they have been clearly, and repeatedly, raised in the Applicant’s previous responses.

II) Claim 3 is premised on the idea that the bridge plate can be disengaged from the coupler end of the second rail road car. There is nothing in Black, Jr., that shows this capability.

The former argument concerning “proper tooling” has now, apparently, been abandoned by the Examiner. However, new grounds were cited in the Office Action of May 17, 2004, namely that, since Black’s internal bridge plates are secured by a bolt “[t]he connection is such that the bridge plate beam is disengageable from the railroad car whenever needed, as explained above as shown in fig. 8 since the bridge plate is secured by bolt 105.”

The Applicant disagrees. Even Black’s internal bridge plates are not shown to be “disengageable” within any reasonable interpretation of the claim language.

Whether or not a threaded fastener or some other connection means is used, the assertion in the Office Action is that Black's internal bridge plates can be disengaged, provided that a person skilled in the art is prepared to dismantle Black's apparatus. Whether, as is now implicit rather than explicit, that requires "proper tooling" for disconnecting threaded fasteners, or some other tooling, or not, it remains that to establish grounds for rejection under 35 U.S.C. §102, the Office Action is required to show a clear teaching. The Office Action does not identify any such clear teaching to dismantle Black's apparatus.

The law requires that references be read as a whole. There is no indication in Black, let alone a clear teaching, that the parts are intended to be taken apart after they have been assembled, nor is there any indication that, as an ordinary incident of the normal course of daily operation by railyard personnel, nor that they are intended to be taken apart, nor that it is desirable for them to be taken apart on a casual basis to permit the bridge plates to be disengaged, as the rejection, rather incredibly, appears to suggest by stating that the internal bridge plates are "... disengageable from the railroad car *whenever needed...*" (Emphasis added) At a permanent articulated connection ? Black shows, *and claims*, a platform assembly for spanning the permanent articulated connection between two adjoining units of a single articulated railroad car. It is clearly intended to be employed on a permanent or substantially permanent basis.

In previous correspondence, the Applicant requested, in the event that the Examiner was unwilling to concede this point, a demonstration, by column and line number or by Figure and item number, where in the Black reference there is any indication (let alone a clear teaching as required) that the features identified by the Examiner are (a) intended to be taken apart after assembly; or (b) are intended to be dismantled as an ordinary incident of operation to permit plates 32 to be disengaged. No such demonstration has been provided.

The Examiner contends that Black's apparatus can be taken apart, thus yielding (in the Examiner's view) the presently claimed invention. However, if one considers Black Jr., Figure 1, 2 and 4, and the description at col. 9, lines 50 – 60, it is not clear how plates 34 can be lifted off studs 102 as long as platforms 30a and 30b are in place, given the physical relationship between decks 44, plates 32, studs 102, platforms 30a and 30b, and wear bars 110, 112 and 114. As such, the Applicant again submits that a person skilled in the art would recognize the Black Jr., structure as being one intended to be permanent, rather than "disengageable".

Further, the apparatus that the Examiner proposes to dismantle is part of Black's claimed invention. The Applicant respectfully submits that it would be inherently contradictory for there to be a clear teaching in Black, Jr., to dismantle the very invention (such as it may be) that Black clearly does intend to teach, and claim, whether with "proper tooling" or without. The Applicant respectfully submits that a rejection that relies on dismantling part, or all, of the claimed invention taught by the cited prior art reference is not sound. (See: *In re Gordon*, *infra*).

The former assertion was based on a conjecture that the structure was "disengageable", contrary to *Datascope*, *supra*. The current assertion is no less so. Anticipation requires a clear showing in the art. The current rejection relies on information that is clearly not supplied by Black Jr., namely a teaching to dismantle Black's own invention, and, accordingly, the rejection cannot stand.

III) Cross-wise Orientation

Claim 3 is premised on the idea that the bridge plate can be moved from a longitudinal orientation to a cross-wise orientation. There is nothing in Black that suggests that Black's internal plates are, ever have been, ever will be, or were ever intended to be, movable between a longitudinal position and a cross-wise position. On the contrary, the relationship of deck 44, plate 32, and wear bars 110, 112 and 114 and plates 34 would seem to preclude movement to a cross-wise orientation. Therefore it cannot reasonably be said that Black Jr., shows a bridge plate having a fitting permitting movement from a longitudinal orientation to a cross-wise orientation.

IV) Summary Re: Anticipation of Claim 3

In summary, the present rejection relies not merely on (a) an assumption of the ability to dismantle Black's apparatus, but, additionally, on (b) the assumption that Black's apparatus is *intended* to be dismantled in the ordinary course; on (c) the assumption that a person skilled in the art would *infer* the ability to dismantle Black's apparatus, on (d) the assumption that a person skilled in the art would *infer* that Black's apparatus is intended to be dismantled as an ordinary incident of operation; on (e) the assumption that a person skilled in the art would infer the *desirability* of being able to dismantle Black's apparatus; and finally on (f) the assumption that the person skilled in the art would *construe* all of these things to mean "disengageable".

The Applicant respectfully submits that a rejection made on this basis clearly does not satisfy the test for anticipation under 35 U.S.C. §102. The Applicant submits that none of the rejections of claim 3 or any claim dependent from claim 3, made under 35 U.S.C. §102 on the basis of US Patent 5,782,187 of Black, Jr., et al., are supportable. The Applicant respectfully requests that the rejections be reconsidered and withdrawn.

V) Claim 13 and Claims 14 – 15 Dependent Therefrom

In the context of Claim 13, as applicable, the Applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black, Jr., of a bridge plate for spanning a lengthwise gap between corresponding vehicle decks of a pair of first and second releasably coupled rail road cars, let alone where the bridge plates are disengageable from the adjacent railroad car. The Applicant respectfully requests that the rejections of claims 13 to 15 under 35 U.S.C. §102 in light of Black be reconsidered and withdrawn.

VI) Claims 20 and 23

In the context of Claims 20 and 23, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black, Jr., of a bridge plate for spanning the gap at the coupler ends between a pair of first and second releasably coupled rail road cars, let alone such a plate in which the bridge plate is disengageable from the adjacent railroad car. The applicant respectfully requests that the rejections of claims 20 and 23 under 35 U.S.C. §102 in light of Black be reconsidered and withdrawn.

VII) Claim 24 and claim 25, 26 and 29 – 32 dependent therefrom

In the context of Claims 24, 25, 26 and 29 - 32, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars in which the bridge plates are disengageable from the adjacent railroad car. The applicant respectfully requests that the rejections of claims 24 – 26 and 29 - 32 under 35 U.S.C. §102 in light of Black be reconsidered and withdrawn.

Claim Rejections Under 35 U.S.C. §103

Statement of the Law

(a) MPEP Section 2142: Basic Requirements of a *Prima Facie* Case of Obviousness

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F. 2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

(b) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)

(c) Must Have Teaching, Suggestion, or Incentive to Combine

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir., 1984.). Cited in *In re Geiger*, 815 F.2d at 688, 2 U.S.P.Q.2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 U.S.P.Q. 2d 1430, 277 F.3d 1338 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee*, *infra*; see also *Ex Parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) Inquiry Must Present a Convincing Line of Reasoning

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

...

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986).”

(e) Inquiry Must Be Thorough And Searching

“The factual enquiry whether to combine the references must be thorough and searching. *Id.*, It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. ...

“The need for specificity pervades this authority. See e.g.,

In re Kotzab 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”);

In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”);

In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).”

(*In re Lee*, 61 U.S.P.Q.2d 1430, 277 F.3d 1338, (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*).

(f) “Would have been obvious to one skilled in the art”

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination “would have been obvious to one skilled in the art” is improper if made without support. *In re Lee, supra*, and *In re Garrett* 132 U.S.P.Q. 514 (Pat. Off. Bd. App. 1961).

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

(g) Destruction of Function

“If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)

Claim Rejections Under 35 U.S.C. §103: Claims 8, 12, 18 and 28

US Patent 5,782,187 of Black, Jr., and US Patent 3,195,478 of Thompson

The Examiner has cited the combination of Black, Jr., et al., and Thompson, against claims 8, 12, 18 and 28. According to the Office Action, Black teaches all of the limitations of claims 12, 18 and 28 except for (a) a railroad car bridge plate having traction bars on the upper surface and (b) a handgrab mounted thereto.

US Patent 5,782,187 of Black, Jr. and US Patent 4,721,426 of Bell:

Reasoning in Office Action is Based on Mistaken Premise

Curiously, although neither the Office Action of December 24, 2003, nor the Office

Action of May 17, 2004 explicitly states that any of claims 8, 12, 18 or 28 is unpatentable in view of US Patent 4,721,426 of Bell, nonetheless the commentary in the Office Actions of December 24, 2003 and of May 17, 2004 still discuss Bell. The Applicant assumes that this is an inadvertent word processing error. In the event that it is not, the Applicant repeats the arguments previously made with respect to Bell, and the proposed combination thereof with Black Jr., et al. The Office Action states:

“The general concept of using traction bars on the top surface of an Aluminum bridge plate assembly of two railroad car units is well known in the art as illustrated by Bell et al., see fig. 1, column 1, lines 60 –67, column 2, lines 49 – 51.”

and further,

“It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Black, Jr., et al., to include the use of traction bars on the top surface of an Aluminum bridge plate assembly in his advantageous bridge plate as taught by Bell et al., ...”

These statements founder on the fundamental factual problem that the Bell reference does not show traction bars.

- (a) The first location cited by the Examiner is Fig. 1. Figure 1 shows a top view of a relatively conventional channel. There are no tread bars shown in this view.
- (b) The second location cited by the Examiner is column 1, lines 60 – 67. They read as follows:

“Referring to FIG. 3, the cross-section of the plate between the hinged end and the tapered dock end includes several trusses partly responsible for being able to construct the plate entirely of aluminum and of minimum thickness at that.”

There are no tread bars referred to in this quotation.

- (c) The third location cited by the Examiner is column 2, lines 49 – 51. Column 2, lines 49 – 51 read as follows:

“The brace plate should also maintain a flat dimensional integrity for tread surface 12. This construction ...”

There is no mention of tread bars here either. On the contrary, the reference to tread surface 12 is to the upper smooth surface of the plate upon which wheeled vehicle can roll, and which lies flat. There are no tread bars mounted to surface 12.

In conclusion, the cited Bell reference simply does not show the features alleged by the Examiner, and upon which the rejection relies. To the extent that this rejection is founded on a false premise, the applicant respectfully submits that no basis for a *prima facie* rejection under 35 U.S.C. §103 has been established. Therefore the applicant respectfully requests reconsideration of the rejection, withdrawal of the rejection, and allowance of the claim so rejected.

Black Jr., and Bell: No Suggestion, Motivation or Incentive Demonstrated

The applicant notes that the Examiner has failed to identify any feature in any of the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references. As such no *prima facie* ground for rejection has been established under 35 U.S.C. §103. That ground alone is sufficient basis for the applicant respectfully to request withdrawal of the current rejections.

US Patent 3,195,478 of Thompson

The Examiner again contends that it would have been obvious to one of ordinary skill in the art to modify the bridge plate of Black, Jr., et al., to include the use of a handgrab as taught by Thompson.

As a preliminary matter, for the reasons discussed above, the applicant traverses the contention that Black teaches all of the limitations of claims 8, 12, 18 and 28 except traction bars and a handgrab. Furthermore, the rejection rests on the premise that Bell has the features identified in the Office Action, (which it does not, as discussed above). However, even if it were true, (which it is not), the rejection would fail for lack of motivation, suggestion or incentive to combine.

Thompson has a handle to permit Thompson's bridge plate to be raised and lowered between "a loading position and a transit position" (Thompson col. 2, lines 14 – 21: "It is an object of the present invention to provide ... a bridge plate ... at the end of the flat car ... which bridge plates are adapted to be swung from a loading position to a transit position." (*i.e.*, the loading position, across the gap, is not the transit position – the antithesis of staying in place during transit).

First, the office action presumes that someone would want to "facilitate rotation of [Black's]

bridge plate”. There is no explanation of why anyone would ever want, or need, to rotate Black’s bridge plate in the first place: Black shows a permanent installation. The office action fails to address this point.

Second, there is a presumption that the “railroad cars” are “disconnected for service”. As a matter of interpretation, the Applicant suspects that the Examiner meant “disconnected for servicing”, namely for repair or maintenance, rather than “disconnected for service”. That is, it is difficult to see how the disconnected portions of an articulated railroad car could be put into service. In any case, as noted several times, (a) Black does not show railroad cars (plural), but rather one railroad car (singular); and (b) there is nothing, apparently, in Black or any other reference, about Black’s invention being “disconnected for service”.

Third, Black does not have, and does not need, a handle to swing the plate, because Black’s internal bridge plates are apparently not intended to be, and may not be able to be, swung to a cross-wise position.

Fourth, Thompson clearly teaches away from the present invention by teaching that it is “an object” of his invention to provide a bridge plate that is movable to a vertical transit position, not one that can stay in place spanning the gap between the cars during transit. (See also Thompson col. 3 lines 45 et seq., noted above).

The Office Action does not address these points.

Black and Thompson: Suggestion Motivation or Incentive Demonstrated

None of the Office Actions has identified a source in the objective art of record from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine Black and Thompson (let alone Black, Bell and Thompson) to arrive at the invention of any of claims 8, 12, 18 and 28. As such no *prima facie* ground for rejection has been established under 35 U.S.C. §103. On that ground alone, if no other, the applicant respectfully submits that it is entitled to request withdrawal of the current rejection of claims 8, 12, 18 and 28.

Black and Thompson: No Reason to Combine

Thompson’s handgrabs are intended for use in swinging the plate into a vertical position for transit. Black, Jr., has internal bridge plates at the permanent articulated connector, in which those internal bridge plates are sandwiched between the underlying decks 44 of the railway car

units and the overlying platforms **30a** and **30b**. Thus, even if installed, it appears that Thompson's handgrabs couldn't be used to lift the plates in any case, unless the overlying platforms were removed first.

The Examiner suggests that the handgrabs of Thompson would be employed in the apparatus of Black to facilitate rotation of plate **34**. Interesting as this conjecture may be, it fails to address the more basic question: why would anybody need or want to rotate Black's plates in the first place ? There is nothing in Thompson that suggests using handgrabs to pivot plates **34** sideways, and there is nothing in Black, Jr., to suggest a reason why anybody would ever need or want to rotate plates **34** at all, let alone to employ handgrabs for that purpose.

Inasmuch as the bridge plates of Black, Jr. are apparently intended to stay in place spanning the articulated connector between two rail car units, what would Thompson's hand grabs be used for on Black's internal bridge plates? The Examiner has not pointed to any explanation in the objective art of record of why Black's apparently permanently mounted internal bridge plates would ever require, or benefit from having, a handgrab. The applicant submits that a person of ordinary skill in the art would not be motivated to modify Black, Jr., to include the use of a handgrab, whether Thompson's or anybody else's since this modification would not appear to provide any advantage to the Black, Jr., et al., apparatus.

Impermissible Hindsight Analysis

The Applicant previously specifically requested, if this rejection were upheld, that, in accordance with *In Re Kotzab*, the Examiner demonstrate where in the objective art of record in this case, there is an explanation of why a person skilled in the art would be motivated to make the proposed combination. There has been no such reply provided.

On the contrary, the reply commentary in the Office Action of May 17, 2004 states:

"... it should be noted that the combination rejection was simply based on a teaching of a handle that is disclosed by the prior art of record, Thompson, which disclose a handle attached to the side of a bridge plate for the purpose of moving the plate out of position."

This is a clear admission that the citation of Thompson was made purely on the basis of an impermissible hindsight analysis, without any basis in the reference (or in any other objective art of record) for finding a suggestion, motivation or incentive for making the proposed

combination with Black, Jr.,. The Applicant respectfully submits that a rejection made on this basis is contrary to law and cannot stand.

Thompson Teaches Against the Invention

Thompson teaches that bridge plates are to be raised in transit. To the extent that any current rejection under 35 U.S.C. §103 employs Thompson, and given that Thompson expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that no rejection under 35 U.S.C. §103 is supported by Thompson.

Black, Jr. and Thompson: References Teach in Opposite Directions

Even in the Examiner's own characterisation of Black Jr. (which the applicant traverses), Black Jr. shows bridge plates, albeit internal bridge plates rather than coupler end bridge plates, that stay in place during train operation. The purpose of the handgrab in Thompson is to facilitate the movement of the bridge plate between the horizontal loading position and the vertical transit position. Thompson (a) shows; (b) includes in the objects of his invention; and (c) claims, bridge plates that are to be raised to a vertical position for transit. The references thus teach in opposite directions. The Applicant respectfully submits that where references teach in opposite directions there is no suggestion, motivation, or incentive to combine, and *prima facie* grounds for rejection have not been established.

Statements of The Law and Application of the Law

Previous Office Actions in this matter contained assertions of law that appear to have been without foundation in the statute, the regulations, or the case law. Indeed, the Applicant respectfully submitted that some of the statements were either incomprehensible, or directly contrary to the law. Since correct application of the law is fundamental to the examining process, the Applicant respectfully and explicitly requested specific clarification of those points.

The Applicant requested a full explanation of those statements in the response to Office Action of August 26, 2002. The Applicant again requested an explanation of those statements in the Response to Office Action of March 18, 2003. For a third time, the Applicant requested an explanation in the Response to Office Action of November 12, 2003. For a fourth time, in the Response to Office Action of March 23, 2004, the Applicant requested a full explanation of the statements of the law formerly made by the Examiner. To date, no such explanation has been

provided.

There is no evidence to show that the Office Actions apply the law, or attempt to apply the law, any differently than as formerly, and erroneously done. In the event that this appeal is rejected, either in whole or in part, the Applicant therefore respectfully requests either (a) an explanation of the former commentary; or (b) (i) an acknowledgement that the former statements of the law were incorrect; and (ii) a demonstrably correct application of the law, MPEP 2142, and *In re Lee* to the currently presented claims and the art of record in this matter.

Conclusion

In view of the foregoing arguments, the applicant submits that claims 3 – 46 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

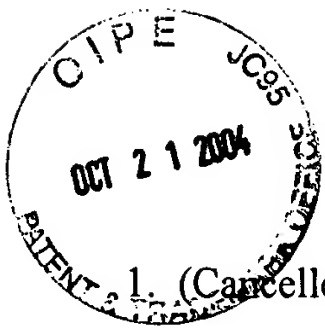
Respectfully submitted,

 19 October 2004

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VIII. Claims Appendix

1. (Cancelled).

2. (Cancelled).

3. (Previously Presented) A rail road car bridge plate operable to permit a vehicle to be conducted between respective vehicle decks of a pair of first and second longitudinally coupled rail road cars, said bridge plate comprising:

a beam locatable in a longitudinal orientation relative to the rail road cars to span a gap therebetween;

said beam having a surface upon which the vehicle can be conducted;

said beam having a fitting by which to mount said beam to the first of the rail road cars;

said fitting being operable to accommodate yawing of said beam relative to the first rail road car when said beam is located in the longitudinal orientation and the rail road cars are in motion; and

said fitting permitting movement of said beam from said longitudinal orientation to a cross-wise orientation relative to the first rail road car when said beam is disengaged from the second rail road car.

4. (Previously Presented) The bridge plate of claim 3 wherein said fitting is chosen from the set of fittings consisting of

(a) a collar for receiving a pivot pin; and

(b) a pivot pin engageable in a collar;

by which said fitting permits motion of said bridge plate between an extended position spanning a gap between the rail road cars and a storage position.

5. (Previously Presented) The bridge plate of claim 3 wherein said fitting is a pivot fitting and, when said beam is lying horizontally, said pivot has a predominantly vertical axis.

6. (Previously Presented) The bridge plate of claim 3 wherein said beam has a flange defining said surface, and said fitting is a pivot fitting having a pivot axis perpendicular to said flange.

7. (Original) The bridge plate of claim 3 wherein said fitting is a pivot fitting having a pivot axis perpendicular to said surface.

8. (Original) The bridge plate of claim 7 wherein said surface has traction bars mounted thereto.

9. (Original) The bridge plate of claim 3 further comprising a second fitting, said second fitting being operable to engage a mating fitting of the second rail road car.

10. (Original) The bridge plate of claim 3 further comprising a second fitting operable to engage the second rail road car, said first fitting being a pivot fitting and said second fitting being a slide fitting.

12. (Original) The bridge plate of claim 3 wherein said beam has at least one hand grab mounted thereto to facilitate manipulation of said bridge plate.

13. (Previously Presented) A bridge plate for spanning a length-wise gap between corresponding vehicle decks of a pair of first and second releasably coupled rail road cars, said bridge plate comprising:

- a beam member for supporting the weight of a wheeled vehicle, said beam member having an upwardly facing surface upon which the vehicle can be conducted between the rail road cars, said beam having first and second ends;

- a first fitting for engaging the first rail road car;

- a second fitting for engaging the second rail road car;

- said first fitting being mountable to connect said first end of said beam to the first rail road car, said first fitting permitting pivotal motion of said bridge plate relative to the first rail road car about a first axis normal to said surface;

- said second fitting being mountable to connect said second end of said beam to the second rail road car, said second fitting permitting pivotal motion of said bridge plate relative to the second rail road car about a second axis normal to said surface;

- said second fitting being operable to accommodate variation of distance between the first and second axes while said rail road cars are coupled together and in motion and one of said first and second fittings being disengageable.

14. (Previously Presented) The bridge plate of claim 13 wherein, when the rail road cars are uncoupled, said second end of said bridge plate is disengageable from the second rail road car, and, when so disengaged, is movable about said first axis to a cross-wise storage position.

15. (Original) The bridge plate of claim 13 wherein said second fitting includes a slide capable of linear motion relative to the second axis.
18. (Original) The bridge plate of claim 13 wherein said second end of said beam has a handgrab to facilitate manipulation of said beam.
20. (Previously Presented) A bridge plate for spanning a gap between corresponding vehicle decks of a pair of first and second releasably coupled rail road cars, said bridge plate having:
 - a first pivot fitting mountable to the first rail road car, said pivot fitting permitting pivotal motion of said bridge plate relative to the first rail road car about a first vertical axis;
 - a second fitting for engaging the second rail road car, said second fitting including a linear extension member permitting pivotal motion of said bridge plate relative to a second vertical axis fixed relative to the second rail road car;
 - said first fitting being tolerant of yaw motion of the bridge plate relative to the first rail road car when said first fitting is mounted thereto;
 - said second fitting being disengageable relative to the second rail road car;
 - said second fitting being tolerant of yaw motion of the bridge plate relative to the second rail road car when said second fitting is engaged thereto; and
 - said linear extension member tolerating variation in distance between the first and second axes.
23. (Previously Presented) The bridge plate of claim 20 wherein said linear extension member is a slot defined in said beam.
24. (Previously Presented) A bridge plate kit for spanning a gap between respective vehicle decks of a pair of first and second releasably coupled rail road cars, said kit comprising:
 - a bridge plate;
 - a first pivot pin having a first pivot axis, said first pivot pin being mountable to the first rail road car with said first pivot axis in a vertical orientation;
 - a second pivot pin having a second pivot axis, said second pivot pin being mountable to the second rail road car with said second pivot axis in a vertical orientation;
 - and
 - said bridge plate having
 - a track surface upon which a vehicle can be conducted between the railroad cars when said bridge plate is mounted to span the gap;

a first fitting in engagement with said first pivot pin, said bridge plate being pivotable relative to said first pivot axis;
a second fitting in engagement with said second pivot pin, said bridge plate being pivotable relative to said second axis;
said bridge plate being translatable relative to said second axis; and
one of said pivot pins being disengageable.

25. (Original) The bridge plate kit of claim 24 wherein said first fitting is a collar matable with said first pivot pin, and said second fitting is a guide matable with said second pivot pin.

26. (Original) The bridge plate kit of claim 24 wherein said bridge plate includes a beam member for supporting loads to be conducted between the first and second rail road cars, said first fitting is a collar mounted to said first pivot pin, and said second fitting is an elongated slot, said second pivot pin being seated in said slot.

28. (Original) The bridge plate kit of claim 24 wherein said second pivot pin is removable from the second mounting, and said bridge plate has hand grabs to facilitate pivoting of said bridge plate by hand about said first pivot pin.

29. (Previously Presented) The bridge plate kit of claim 24 wherein said kit includes two of said bridge plates, two of said first fittings and two of said second fittings whereby said bridge plates, when installed, co-operate as a pair of side-by-side wheel trackways to define a pathway between the first and second rail road cars.

30. (Previously Presented) The bridge plate kit of claim 24 wherein said disengageable one of said pivot pins is disengageable from its respective rail road car.

31. ((Previously Presented) The bridge plate of claim 24 wherein said disengageable one of said pivot pins is removable disengageable from its respective fitting of said bridge plate.

32. ((Previously Presented) The bridge plate of claim 24 wherein said second pivot pin is said disengageable pivot pin.

IX. Evidence Appendix

No additional evidence is submitted at this time.

X. Related Proceedings Appendix

There are no related proceedings.